

### **Remarks**

Reconsideration of the application is respectfully requested in view of the following remarks. Upon entry of this response, claims 4-7, and 13-26 remain in the application. Claims 1-3 and 8-12 have previously been canceled without prejudice.

### **Claim Rejections Under 35 USC § 103(a)**

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. [MPEP § 2142.]

#### ***Claims Rejected Over a Proposed Herz-Connelly-Alexander Combination***

The Office asserts that claims 13, 4 and 5 are unpatentable over Herz, U.S. Patent No. 5,758,257 (“Herz”) in view of Alexander, U.S. Patent No. 6,177,931 (“Alexander”) and further in view of Connelly, U.S. Patent No. 6,144,376 (“Connelly”).

#### ***Claim 13.***

Applicants respectfully assert that Herz, Alexander, and Connelly, either separately or in combination, fail to teach or suggest, at least, the language of claim 13 “*wherein upon returning to an interactive entertainment channel, the system automatically cycles through plural selections in the determined affinity grouping.*”

The Action states, in its rejection of the above claim language, “Herz teaches creating virtual channels, which assemble programming ‘predicted to be most desirable’ to the user. These virtual channels are displayed on dedicated channels, which when selected automatically present the recommended programming.” [Action of November 1, 2007 (hereinafter “Action”), p. 2.]

In support of this position, the Action directs Applicants to the following passage in Herz to teach or suggest the above limitation:

The same approach is then used to develop "virtual channels" at the set top multimedia terminals based on domain or genre or tastes of individuals so that the customer can view the video programming predicted to be most desirable to that customer. The "virtual channels" may be displayed on dedicated channels, or the recommended programming may be highlighted directly on the electronic program guide or displayed on the customer's screen as recommended

programming selections. Also, the channels may be reprioritized for presentation on the electronic program guide on the basis of the calculated "virtual channels". [Herz, 48:36-47.]

Neither Herz nor the rejection make mention of the claim 13 feature "automatically cycling." The Action does state that the virtual channels "automatically present" the recommended programming. However, even assuming, for argument's sake, that Herz does teach *automatically presenting* programming, this does not teach or suggest automatic *cycling*. Herz, therefore cannot teach or suggest the claim 13 limitations "the system *automatically cycles* through plural selections in the determined affinity grouping." Moreover, neither Connelly nor Alexander, either separately or in combination with Herz, teach or suggest the above claim language.

For at least these reasons, claim 13 is allowable. Such action is respectfully requested.

*Claims 4 and 5.*

Claims 4 and 5 depend ultimately from allowable claim 13. Since they depend from an allowable claim, they should be allowed for at least the reasons stated for claim 13. Applicants also point out these claim recites novel and nonobvious features allowable over the proposed Herz- Connelly -Alexander combination. Claims 4 and 5 should be allowable. Such action is respectfully requested.

***Claims Rejected Over a Proposed Herz-Yoshinobu-Alexander Combination***

The Office asserts that claims 6, 20, and 21 are unpatentable over Herz, in view of Yoshinobu, U.S. Patent No. 5,734,444 ("Yoshinobu") and further in view of Alexander.

*Claim 6.*

Applicants respectfully assert that Herz, Yoshinobu, and Alexander, either separately or in combination, fail to teach or suggest, at least, the amended language of claim 6 "*when a video program has been selected for viewing, receiving indication that the menu button on the remote control has been activated; and in response, displaying a translucent control with a play button on the screen, the play button highlighted; upon receipt of indication that the play button was selected, minimizing the control panel on the screen...*" To applicants' knowledge, the above

feature combination is neither taught nor suggested by the proposed Herz-Yoshinobu-Alexander combination. For at least this reason, claim 6 is in condition for allowance.

*Claims 20 and 21.*

Claims 20 and 21 depend ultimately from claim 6. In the interest of brevity, Applicants do not belabor the language of each of the dependent claims, but point out that they recite novel and nonobvious features allowable over the proposed Herz-Yoshinobu-Alexander combination. Since they depend from an allowable claim, they should be allowed for at least the reasons stated for claim 6. In view of the foregoing discussion of claim 6, the merits of the separate patentability of dependent claims 20 and 21 are not belabored at this time. Claims 20 and 21 should be allowable. Such action is respectfully requested.

***Claims Rejected Over a Proposed Herz-Yoshinobu-Alexander-Lazarus Combination***

The Office asserts a rejection of claims 7 and 14-18 as obvious over Herz and Yoshinobu, in view of Alexander, and in further view of Lazarus, U.S. Patent No. 5,652,613 (“Lazarus”).

*Claim 7.*

Applicants respectfully assert that Herz, Yoshinobu, Alexander, and Lazarus, either separately or in combination fail to teach or suggest, at least, the amended language of claim 7 “*in response to indication of activation of the menu button from the remote control, providing an on-screen video control panel with a play button, the video control panel rendered as a change in luminance of underlying imagery on the screen such that the video control panel appears translucent and the play button is highlighted; in response to indication of activation of the play button, the control panel becoming more transparent...*”

To applicants’ knowledge, the above feature combination is neither taught nor suggested by the proposed Herz-Yoshinobu-Alexander-Lazarus combination. For at least this reason, claim 7 is in condition for allowance.

*Claim 14.*

Applicants respectfully assert that Herz, Yoshinobu, Alexander, and Lazarus, either separately or in combination fail to teach or suggest, at least, the amended language of claim 14

*“instructions for displaying a list of the programs copied to the storage medium on a favorites page; and instructions for automatically playing the single program upon receipt of an indication to display the favorites page when there is only a single program copied to the storage medium.”*

To applicants' knowledge, the above feature combination is neither taught nor suggested by the proposed Herz-Yoshinobu-Alexander-Lazarus combination. For at least this reason, claim 14 is in condition for allowance.

*Claims 15-18.*

Additionally, claims 15-18 ultimately depend from allowable claim 14. In the interest of brevity, Applicants do not belabor the language of each of the dependent claims, but point out that they recite novel and nonobvious features allowable over the proposed Herz-Yoshinobu-Alexander-Lazarus combination. Further, since they depend from allowable claim 14, they should be allowed for at least the reasons stated for claim 14. Claims 15-18 should be allowable. Such action is respectfully requested.

***Claims Rejected Over a Proposed Herz-Yoshinobu-Alexander-Lazarus-Daniels Combination***

The Office asserts a rejection of claim 19 as obvious over Herz, Yoshinobu, and Alexander, in view of Lazarus, and further in view of Daniels, U.S. Patent Publication No. 2002/0032907 (“Daniels”).

*Claim 19.*

Applicants respectfully assert that claim 19 recites novel and nonobvious features allowable over the proposed Herz-Yoshinobu-Alexander-Lazarus-Daniels combination. Further, since it depends from allowable claim 14, it should be allowed for at least the reasons stated for claim 14. Claim 19 should be allowable. Such action is respectfully requested.

***Claims with No Rejection***

The Office has failed to provide rejections for the expressly recited features of the pending dependent claims 22-26. Under the Office's policy of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the

review of the application. (MPEP §707.07(g)). Thus, it is submitted that the Office's failure constitutes a failure to expeditiously provide the information necessary to resolve issues related to patentability that prevents the applicants from, for example, presenting appropriate patentability arguments and/or rebuttal evidence. (See The Official Gazette Notice of November 7, 2003). Accordingly, in the event that the Office maintains the rejection of any of the dependent claims, Applicant respectfully requests that the Office apply art against each feature of each rejected dependent claim, on the record, and with specificity sufficient to support a prima facie case of obviousness.

#### **Claim Amendments**

Support for the claim amendments is found throughout the specification and figures as originally filed. Specifically, support can be found at, e.g., page 7, lines 9-22; page 7, lines 27-31; page 9, lines 5-10; page 12, line 25 to page 13, line 21; page 15, lines 1-17; page 16, lines 11-14, page 17, lines 5-8, and Fig. 7.

#### **Formal Request For Interview**

Upon reviewing this response, if any issues remain, the Examiner is formally requested to contact the undersigned prior to issuance of the next Office Action in order to arrange a telephonic interview. It is believed that a brief discussion of the merits of the present application may expedite prosecution. Applicants submit the foregoing formal Response so that the Examiner may fully evaluate Applicants' position, thereby enabling the interview to be more focused. This request is being submitted under MPEP § 713.01, which indicates that an interview may be arranged in advance by a written request.

**Conclusion**

The claims in their present form should now be allowable. Such action is respectfully requested.

Respectfully submitted,

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